



#24
203

PATENT
0879-0273P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Atsushi MISAWA

Appeal No.:

Appl. No.: 09/663,354

Group: 2612

Filed: September 15, 2000

Examiner: Ngoc Yen T. Vu

For: DIGITAL CAMERA WITH DETACHABLE MEMORY FOR
STORING IMAGE DATA (AS AMENDED)

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)

RECEIVED

AUG 31 2004

Technology Center 2600

RECEIVED
2004 SEP 28 PM 1:25
BOARD OF PATENT APPEALS
AND INTERFERENCES



PATENT
0879-0273P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Atsushi MISAWA

Appeal No.:

Appl. No.: 09/663,354

Group: 2612

Filed: September 15, 2000

Examiner: Ngoc Yen T. Vu

For: DIGITAL CAMERA WITH DETACHABLE MEMORY FOR
STORING IMAGE DATA (AS AMENDED)

RECEIVED

AUG 31 2004

ON BEHALF OF APPELLANT
ATSUSHI MISAWA

Technology Center 2600

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 21, 2004

Sir:

Appellant submits herewith a Reply Brief in triplicate as required by 37 C.F.R.

1.192. This Reply Brief responds to the Examiner's Answer mailed April 22, 2004.

For clarity, the issues presented in the Appeal Brief filed February 10, 2004, will be repeated, and the reply to the Examiner's Answer will substantially correspond structurally to the argument section in the Appeal Brief.

I. ISSUES ON APPEAL:

The issues to be resolved in this application are:

(1) Whether claims 6, 7, 9, and 13-15 are unpatentable under 35 U.S.C. § 103(a) based on the teachings of *Sasson et al.* (USP 5,016,107) (hereinafter *Sasson*) in view of *Wakui* (USP 5,648,816) (hereinafter *Wakui*); and

(2) Whether claims 8 and 10-12 are unpatentable under 35 U.S.C. § 103(a) based on the teachings of *Sasson*, *Wakui*, and *Watanabe* (USP 4,877,161) (hereinafter *Watanabe*).

II. GROUPING OF CLAIMS:

In the Examiner's Answer at "(7) Grouping of Claims", the Examiner asserts the rejection of claims 6-15 stand or fall together, asserting Appellant's brief does not include a statement regarding the grouping of claims. Appellant respectfully notes that in Appellant's Appeal Brief in section "VIII. GROUPING OF CLAIMS", Appellant recites that all claims are separately grouped and argued.

III. REPLY:

A. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 6

1. The Reference Fails to Teach All of the Elements of the Claimed Invention, Thus Failing to Establish *Prima Facie* Obviousness of Independent Claim 6

In responding to Appellant's argument that the references fail to teach all of the claimed elements, in paragraph (11)a., the Examiner asserts that *Sasson* teaches transferring image data from the built-in memory to the detachable memory card upon detecting the mount of the memory card. Specifically, the Examiner asserts that *Sasson* teaches querying for the presence of a detachable memory card in col. 5, ll. 39-56. The

Examiner further asserts that *Sasson* teaches that the compressed image data is directly written into the detachable memory card, citing to col. 7, ll. 30-50 and col. 8, ll. 37-41. Appellant respectfully disagrees with the Examiner's characterization of this reference.

Sasson teaches at col. 5, ll. 39-48 as follows:

The control processor 20 also accesses a card diagnostics memory 31 for generating important information about the condition of the memory card 24. Specifically, the connector 26 is queried for the presence of a card 24 and, if no card is connected, a "no card" display is produced on the operation display 30. Likewise, if a card is present but it is full of images, a "card full" display is produced. The card diagnostics memory 31 also provides a verification routine to check the card 24 for faults or defects.

With regard to Fig. 3, *Sasson* provides details of a specific processing architecture that processes the image data. Upon the conclusion of the image processing, *Sasson* notes at col. 8, ll. 37-41 as follows:

With the image data now in its finally compressed form, and instead of writing the compressed data back into the buffer 39 one more time, the compressed data is directly written into the memory card 24.

However, there is no teaching or suggestion in *Sasson* that is directed to transferring image data from the built-in memory to the detachable memory card upon detecting the mount of the memory card, as asserted by the Examiner.

In paragraph (11)b., the Examiner asserts that *Wakui* cures the deficiencies of the teachings of *Sasson*, asserting that *Wakui* teaches the digital image signal stored in the image memory is automatically transferred to the memory card 31 when the memory card is correctly connected to the camera. Appellant respectfully disagrees with the Examiner's characterization of this reference.

As noted in Appellant's Appeal Brief on page 12, *Wakui* merely teaches interrupting a recording operation upon detection of a card insertion operation. During a recording operation, when it is determined that the IC memory card is inserted into the camera, the recording operation from image memory 7, which stores only one image, to flash memory 20 is stopped and the image data is then recorded on the inserted IC memory card 41. Appellant maintains that there is no teaching or suggestion of digital image signals stored in the built-in image memory being automatically transferred to the memory card when the memory card is correctly connected to the camera as recited in claim 6. *Wakui* merely teaches modifying the recording operation from the flash memory to the IC memory card upon detection of insertion of the memory card.

As neither *Sasson* nor *Wakui*, either alone or in combination (assuming these references are combinable, which Appellant does not admit), teach or suggest memory control means for automatically transferring the image data from the built-in memory to the detachable memory card upon the detecting means detecting the insertion, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. It is respectfully submitted that claim 6 is patentable over *Sasson* in view of *Wakui*.

2. The Rejection Fails to Provide Valid Motivation to Combine the References, Thus Failing to Establish *Prima Facie* Obviousness of Independent Claim 6

In responding to Appellant's argument that there is no motivation to combine the references, the Examiner notes that *Sasson* teaches that it is desirable to unload the image buffer 18 and free memory space for a new frame, citing to col. 3, l. 68 - col. 4, l.

3. The Examiner further asserts that *Wakui* teaches the advantage of automatically

transferring images stored in the image memory upon the insertion of the detachable memory card 31, citing to col. 19, ll. 58-64. The Examiner concludes by asserting it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the electronic camera of *Sasson* the teaching of *Wakui* of automatically transferring the image data from the built-in memory to the detachable memory card upon the detection of the insertion of the memory card in order to free up memory space in the built-in memory for new image frames. Appellant respectfully disagrees with the Examiner's characterization of these references.

While *Sasson*, at col. 3, l. 60 - col. 4, l. 4, seeks to optimize image processing with respect to image buffer 18, there is no indication in *Sasson* that teaches or suggests operating the camera without a memory card being present. *Sasson* merely seeks to provide continuous shooting capability of a successive sequence of images. There is no indication that the image buffer 18 is to be used as a "built-in memory" for use without a memory card being inserted in the camera.

Wakui additionally fails to provide motivation as asserted by the Examiner. As noted above, *Wakui* fails to teach automatically transferring the image data from the built-in memory, storing a plurality of images in the form of image data, to the detachable memory card upon the detecting means detecting the insertion. As depicted in Fig. 9 of *Wakui* and its related discussion at col. 13, l. 39 - col. 14, l. 67, if the system determines that the memory card is not inserted and there is insufficient storage in flash memory (also external memory), no photographing operation may take place. As such, there is no indication that image memory 7 may be used as built-in memory for use

without the detachable memory being inserted in the camera. As such, no motivation can be found in the *Wakui* reference.

Additionally, In paragraph (11)e., the Examiner asserts that it is inherent that the electronic camera taught in *Sasson* can continuously capture a plurality of images and store the images in the image buffer without the insertion of the detachable memory card. Appellant respectfully disagrees with this assertion.

Sasson provides for digital processing of image signals corresponding to a still image and storage of the processed image signals in a removable static random access memory card (Abstract). The digital processor operates on the stored digital signals, transforming blocks of the digital signals and encoding the signals into a compressed stream of processed image signals, which are downloaded to the memory card. The electronic still camera seeks to provide image buffer 18 with the ability to store a plurality of still images wherein images are processed and downloaded to the memory card in an attempt to free memory space for a new frame as soon as the older ones are processed (col. 3, l. 65 - col. 4, l. 3).

There is no indication in the *Sasson* reference that provides any indication that the camera can be operated without the memory card being inserted. The provision for an image buffer that can store a plurality of images is to provide the ability to shoot a successive sequence of images. It is not inherent that the electronic camera taught in *Sasson* can operate without the insertion of the detachable memory card as asserted by the Examiner.

In paragraph (11)f., the Examiner admits that image memory 7 is not for use without detachable memory being inserted in the camera. The Examiner asserts that

she is relying on the teachings of *Sasson* to teach this element. However, as noted above, *Sasson* fails to provide any indication that the camera can be utilized without a memory card being inserted in the camera.

As there is no motivation in either of the references cited by the Examiner, the Examiner's conclusion that the combination of the references for teaching the claimed invention amounts to impermissible hindsight as the Examiner is essentially relying on the Appellant's specification to provide motivation. As there is no motivation for the combination of the references, it is respectfully submitted that claim 6 is patentable over *Sasson* in view of *Wakui*.

B. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 9

In responding to Appellant's argument with regard to claim 9, in paragraph (11)h., the Examiner asserts that it is inherent that the electronic camera taught in *Sasson* can continuously capture a plurality of images and store the images in the buffer without the insertion of the detachable memory card. The Examiner notes that memory card 24 may be used to store many compressed image signals. For the reasons noted above, Appellant maintains his position that the references fail to teach or suggest the claimed invention.

While the Examiner asserts that *Sasson* can continually capture a plurality of images and store the images in the image buffer without the insertion of the detachable memory card, it is respectfully submitted that that is insufficient to teach "wherein the detachable memory card is mainly for attachment when the digital camera is not being used to capture images and is normally detached when the digital camera is being used to capture images," as recited, *inter alia*, in claim 9.

First, as noted above, *Sasson* fails to inherently teach utilizing the camera without the insertion of the detachable memory card. Even assuming, *arguendo*, that *Sasson* does teach operating the camera without the insertion of the detachable memory card, it is respectfully submitted that this teaching is insufficient to teach the claimed element as recited in claim 9. Claim 9 provides for, *inter alia*, a detachable memory card being mainly for attachment when the digital camera is not being used to capture images. *Sasson* merely provides for storing three images. This would ultimately result in a camera that has very limited use. It would be extremely cumbersome for a user to have to insert the memory card to download the images for every third picture that the user takes. As such, *Sasson* fails to teach or suggest the detachable memory card being mainly for attachment when the digital camera is not used to capture images and is normally detached when the digital camera is being used to capture images as set forth in claim 9.

C. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claims 14 and 15

In paragraph (11)i., the Examiner responds to Appellant's arguments merely by referring to paragraphs (11)a.-(11)d. Appellant disagrees with the Examiner's assertions for the reasons noted above.

D. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 8

In response to Appellant's arguments, the Examiner indicates disagreement with Appellant's assertions. However, the Examiner fails to identify any teachings in any of the references that teach or suggest "wherein the camera body, in an insertional direction of the detachable memory card, is shorter than the detachable memory card in

the insertional direction of the detachable memory card.” The Examiner provides some teachings of *Watanabe* that, arguably, tangentially address the issue. However, Appellant maintains his position that there is no teaching or suggestion in any of the references, either alone or in combination, that teach or suggest this claim element. As the Examiner has failed to provide references that teach or suggest all of the claimed elements, it is respectfully submitted that claim 8 is patentable over the references as cited by the Examiner.

E. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 11

In paragraph (11)k., the Examiner again disagrees with Appellant’s argument that the Examiner has failed to establish *prima facie* obviousness. However, the Examiner fails to identify any teaching or suggestion in any of the references that teach or suggest wherein when the detachable memory card is inserted into the insertion slot, more than one third of the detachable memory card is exposed in an insertional direction of the detachable memory card.

The Examiner provides, *arguendo*, tangentially related teachings of *Watanabe*. However, as the Examiner has failed to provide any reference that teaches or suggests this claim element, it is respectfully submitted that claim 11 is patentable over *Sasson*, *Wakui*, and *Watanabe*.

IV. CONCLUSION

For the reasons set forth above and for the reasons contained in the original Appeal Brief, Appellant respectfully submits that all claims of the present application are allowable. Thus, favorable reconsideration and reversal of the Examiner’s rejection of

claims by the Honorable Board of Patent Appeals and Interferences is respectfully requested.

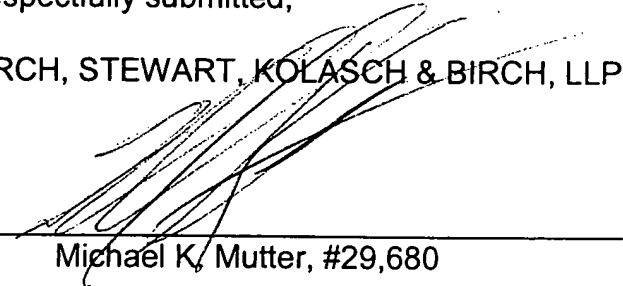
Should there be any outstanding matters that need to be resolved in the present Appeal, the Examiner or Honorable Board is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at (703) 205-8000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


Michael K. Mutter, #29,680

MKM/CMV/jdm
0879-0273P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000